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BRIAN ROFFE, ESQ 11 SUNRISE PLAZA, SUITE 303 VALLEY STREAM, NY 11580-6111			LOCKETT, KIMBERLY R	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK DRONGE

Appeal 2009-001116
Application 10/620,235
Technology Center 2800

Decided:¹ July 27, 2009

Before JOSEPH F. RUGGIERO, MARC S. HOFF, and ELENi MANTIS
MERCADER, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Final Rejection of claims 8, 9, 12-14, and 17. Claims 1-6 have been allowed by the Examiner, claim 7 has been cancelled, and claims 10, 11, and 16 have been indicated

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

by the Examiner to be allowable if rewritten in independent from. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief (filed January 11, 2007), the Answer (mailed October 3, 2007), and the Reply Brief (filed December 3, 2007) for the respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellant's Invention

Appellant's invention relates to a string set for a musical string instrument which includes at least four strings with each of the strings having a color different from the other strings and a size different than the size of the other strings. The strings are mounted on the musical string instrument to enable playing of the instrument by association of a colored note on a sheet of music with the colors of the strings. (*See generally* Spec. 2:27-3:6).

Claim 8 is illustrative of the invention and reads as follows:

8. A set of strings for a musical string instrument, comprising:
at least four strings, each of said strings having a color different than the color of the other of said strings in said set and a size different than the size of the other of said strings in said set,

said strings being adapted to be mounted on the instrument to enable playing of the instrument by association of a colored note on a sheet of music to the colors of said strings.

The Examiner's Rejection

The Examiner's Answer cites the following prior art references:

Roberts	US 3,820,434	Jun. 28, 1974
Nilsson	US 5,268,971	Dec. 7, 1993
Sperzel	US 5,492,044	Feb. 20, 1996

Claims 8, 12, 13, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Roberts in view of Sperzel.

Claims 9 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Roberts in view of Sperzel and Nilsson.

ISSUE

The pivotal issue before us is whether Appellant has demonstrated that the Examiner erred in determining the obviousness to the skilled artisan of combining the colored musical instrument string teachings of Roberts with the differently sized musical instrument string teachings of Sperzel, with the further addition of the color coded core wire wrapping teachings of Nilsson.

FINDINGS OF FACT

The record supports the following relevant findings of fact (FF) by a preponderance of the evidence:

1. Roberts discloses (Fig. 1; col. 2, ll. 25-35) an instruction system for teaching students how to play a stringed musical instrument, such as a guitar, by providing each of the strings of the musical instrument with a different color.

2. Roberts further discloses (Fig. 4, col. 1, ll. 1, ll. 42-47, col. 3, ll. 13-16, and col. 4, ll. 19-23) that the instruction system uses a color coded music notation sheet in conjunction with the colored string set.

3. Sperzel discloses (Fig. 3; col. 3, ll. 60-65) that the string set of a conventional stringed musical instrument of a guitar type has strings with diameters that have varying sizes.

4. Nilsson discloses (col. 3, ll. 22-24) a cable in which core wires are wrapped with a color coded wrapping for identification purposes.

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (stating that 35 U.S.C. § 103 leads to three basic factual inquiries: the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the art). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore,

‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Also, “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR*, 550 U.S. at 416). “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *KSR*, 550 U.S. at 419-20.

ANALYSIS

I. The rejection of claims 8, 12, 13, and 17 based on the combination of Roberts and Sperzel.

With respect to the Examiner’s obviousness rejection of representative independent claim 8 based on the combination of Roberts and Sperzel, Appellant’s arguments in response assert a failure by the Examiner to establish a prima facie case of obviousness since a proper basis for the

Examiner's proposed combination of references has not been established.² Appellant's arguments focus on the contention that a skilled artisan would not combine Roberts and Sperzel as proposed by the Examiner. According to Appellant (App. Br. 5-6), the varying string size teaching of Sperzel, which is not directed to teaching a student how to play an instrument, adds little value to Roberts since Roberts discloses that the coloring of strings alone is sufficient for the learning process.

We do not agree with Appellant. As correctly recognized by the Examiner (Ans. 3), Sperzel provides an evidentiary disclosure (FF 3) that string instruments with uncolored strings that have diameters of varying size are conventional in the art. In fact, this is nothing more than what is acknowledged by Appellants at page 1, lines 10-14 of the Specification.

Further, Appellant's arguments (App. Br. 5) correctly recognize that Roberts provides a disclosure (FF 1) of teaching a student to play a stringed instrument by adding color to the strings of the string set of a stringed instrument to distinguish between the various strings. Appellant also recognizes (*id.*) that Roberts also discloses (FF 2) that the colored strings, when used in combination with a color-coded musical notation sheet, aid in teaching a student how to play a stringed instrument.

With the above discussion in mind, we fail to see why the collective teachings of Roberts and Sperzel would not have suggested to the ordinarily skilled artisan the obviousness of adding color to the varying size uncolored

² Appellant argues rejected claims 8, 12, 13, and 17 together as a group. See App. Br. 4-9. Accordingly, we select claim 8 as representative. See 37 C.F.R. § 41.37(c)(1)(vii).

strings of conventional stringed instruments to aid in teaching students how to play such instruments. According to *Leapfrog*, when combination of familiar elements according to methods known to the skilled artisan achieves a predictable result, it is likely to be obvious.

For the above reasons, since it is our opinion that the Examiner has established a prima facie case of obviousness based on the combination of Roberts and Sperzel which has not been overcome by any convincing arguments from Appellant, the Examiner's 35 U.S.C. § 103(a) rejection of representative independent claim 8, as well as claims 12, 13, and 17 not separately argued by Appellant, is sustained.

II. The rejection of claims 9 and 14 based on the combination of Roberts, Sperzel, and Nilsson.

In addressing the language of appealed claims 9 and 14, the Examiner has applied (Ans. 4 and 6) the teachings of Nilsson, which are directed to the color coding of core wire wrappings for identification purposes (FF 4), to the collective teachings of Roberts and Sperzel. We find no convincing arguments from Appellant that convince us of any error in the Examiner stated position and, accordingly, this rejection is sustained.

In particular, we find to be without merit Appellant's argument (App. Br. 9-10) that the applied Nilsson reference is from a disparate and non-analogous art. Appellant correctly states (*id.*) that the test for non-analogous art is first whether the art is within the field of the inventor's endeavor and, if not, whether it is reasonably pertinent to the problem with which the inventor was involved. *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979). A reference is reasonably pertinent if, even though it may be in a different field

of endeavor, it logically would have commended itself to an inventor's attention in considering his problem because of the matter with which it deals. *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992).

We do agree with Appellant that Nilsson cannot reasonably be interpreted as relating to Appellant's field of endeavor of providing instruction for stringed musical instruments. We are in agreement with the Examiner (Ans. 6), however, that Nilsson's teaching of providing color coded wrapping to core wires for identification purposes is reasonably pertinent to the problem addressed by Appellant, i.e., the use of color coding to distinguish between the different wire strings of a musical instrument. Accordingly, we find no error in the Examiner's finding that the ordinarily skilled artisan would have logically consulted the color coded wire wrapping teachings of Nilsson in attempting to solve problems associated with teaching students how to play a stringed instrument by using color coding to identify and distinguish the differently sized wire strings of a musical instrument as taught by the collective teachings of Roberts and Sperzel.

III. The 37 C.F.R. § 1.132 declarations of Dronge and Mari

In support of Appellant's position of nonobviousness of the claimed invention, Appellant has submitted declarations by Mark Dronge, the named inventor of the present application, and Daniel Mari, purporting to show evidence of commercial success and long-felt need of the present claimed invention. We agree with the Examiner (Ans. 5-6), however, that the evidence provided by the Dronge and Mari declarations is not sufficient to overcome the prima face case of obviousness set forth by the Examiner.

The Dronge declaration relies on the number of units of the learning string set sold and the total dollar revenue as providing evidence of commercial success. The declaration, however, provides no data concerning whether the amount of sales of the learning string set represents a substantial share of the market. Our reviewing court has noted in the past that evidence related solely to the number of units sold provides a very weak showing of commercial success, if any. See *In re Huang*, 100 F.3d 135, 137 (Fed. Cir. 1996); *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1026-27 (Fed. Cir. 1985) (finding that sales of 5 million units represents a minimal showing of commercial success because “[w]ithout further economic evidence . . . it would be improper to infer that the reported sales represent a substantial share of any definable market”); see also *In re Baxter Travenol Lab.*, 952 F.2d 388, 392 (Fed. Cir. 1991).

The evidence provided by the Mari declaration, allegedly showing a long-felt need for the claimed invention, is equally unpersuasive. We find no showing of any objective evidence that establishes that an art recognized problem existed in the learning string set art for a long period of time without solution. In particular, we find no evidence that any such need was a persistent one that was recognized by those of ordinary skill in the art. See *In re Gershon*, 372 F.2d 535, 539 (CCPA 1967). Mr. Mari’s anecdotal recollection that the string set disclosed by the Roberts reference was never sold and the suggested reason for the alleged lack of commercialization is based purely on speculation without evidentiary support.

In the final analysis, evidence of nonobviousness, although being a factor that must be considered, is not necessarily controlling. See *Newell Companies, Inc. v. Kenney Manufacturing Co.*, 864 F.2d 757, 768 (Fed. Cir.

1988). In view of the foregoing, we are satisfied that when all the evidence and arguments are considered, the evidence of nonobviousness fails to outweigh the evidence of obviousness as in *Richardson-Vicks Inc. v. Upjohn Co.*, 122 F.3d 1476 (Fed. Cir. 1997) and *EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898 (Fed. Cir. 1985).

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellant has not shown that the Examiner erred in rejecting appealed claims 8, 9, 12-14, and 17 for obviousness under 35 U.S.C. § 103.

DECISION

The Examiner's 35 U.S.C. § 103 rejection of claims 8, 9, 12-14, and 17, all of the appealed claims, is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

JRG

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